

REMARKS

Claims 31-65 and 83-92 are pending in this application. Claims 31, 37, 43, 48, 54, and 60 are in independent form. No claims have been amended.

All of the pending claims have been rejected over U.S. Patent No. 6,230,073 (hereinafter “Kofman”) in view of U.S. Patent Application Publication No. 2002/0095231 (hereinafter “Yu”) and U.S. Patent No. 6,058,843 (hereinafter “Young”). This is a new grounds of rejection. The status of the references as prior art under 35 U.S.C. § 102(e) is assumed for purposes of this response, but not conceded.

As presently claimed, and as previously discussed in person with the Examiner, the system involves either a sugar shell candy substrate (such as M&M’S® Milk Chocolate and Peanut Chocolate Candies) or a jellybean substrate. These substrates have non-planar printing surfaces with surface characteristics that render them difficult to print on. Consequently, the consumer conventionally has not been able to participate in the design of such products. Moreover, the claimed printer is a high resolution ink-jet printer, which has not been used to print on these types of confectionery products.

In the new grounds of rejection, the Examiner alleges that Kofman discloses a system for enabling a user to submit a customizable image to be printed directly on a non-planar surface of a sugar shell or jellybean. However, there is no such disclosure in Kofman.

Kofman does not teach a non-planar printing surface. The “circle,” “oval” and “polygonal” shapes referenced at Kofman col. 5, lines 8-10 are two-dimensional shapes. These shapes describe the outline of the product, and not the printing surface. Contrary to the assertion in the Office Action, the “surface for printing” shown in Fig. 3 is planar. In fact, from the entire discussion in Kofman, showing how the distance between

the printhead and the printing surface may be adjusted (see, for example, col. 6, lines 54-61), it is clear that the reference is directed to printing on planar printing surfaces. The use of a roller as shown in Kofman Fig. 8, and described at col. 6, lines 36-41, further makes clear that the printing surface is planar. Kofman, col. 3, lines 34-36, describes the fixed position of the printhead with respect to the substrate, which further makes clear that the printing surface is planar. Thus, Kofman does not disclose printing on a non-planar sugar shelled item or jellybean, as claimed.

Kofman is also directed to printing on chocolate, not sugar shell candy, as can be plainly seen from, for example, Kofman at col. 4, lines 36-41 and 50-51. The Kofman specification suggests that the printing system described therein can be used with “a food item selected from the group consisting of chocolate, cheese and the like” (see Abstract). As chocolate and cheese are fat-based, one of ordinary skill in the art seeking to modify that disclosure would not expect that that sugar shell candy would be contemplated as a printing substrate. To the contrary, the drawings of the apparatus in Kofman do not suggest that it could be used to print on individual pieces of candy.

Yu also does not teach printing a high resolution image on a non-planar printing surface of a sugar shell substrate. Yu is directed to printing on cakes. However, the consumer has conventionally been able to customize cake decoration (see, for example, Yu paragraph [0007], and the many cake-decorating patents cited during prosecution of this case). The present invention is directed to printing on a non-planar sugar shell surface or jellybean surface. Consumers have not conventionally been able to customize printing on these confectionery items. It is not obvious to take what Yu teaches about consumer customization of one edible product, where there has been a history of consumer

involvement in the decoration process, and apply it to a different edible product, where there has not been any such prior history of consumer involvement.

Young also does not teach printing on non-planar sugar shell surfaces and therefore does not overcome the deficiencies of the other references.

The differences between the prior art and what is presently claimed would not have been obvious to one of ordinary skill in the art, at least because printing high resolution images on shaped sugar shell candies is significantly different from decorating cakes or chocolate tablets. Consumers conventionally have not been able to customize M&M's® Milk Chocolate and Peanut Chocolate Candies, for example, especially not with high resolution images, as presently claimed. The Office Action fails to address the element of the claimed printing subsystem, and what motivation would have led one of ordinary skill in the art to bring consumer customization to that printing subsystem.

Reconsideration and prompt passage to issue are respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should be directed to our address given below.

Respectfully submitted,



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